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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,672	05/24/2001	Bradley Alan Sparks	RCA 88,397	3803
7590 10/06/2005			EXAMINER	
Joseph S. Tripoli Thomson Multimedia Licensing Inc. Patent Operation, Two Independence Way P.O. Box 5312 Princeton, NJ 08543-5312			SHIBRU, HELEN	
			ART UNIT	PAPER NUMBER
			2616	
DATE MAILED: 10/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/864,672	SPARKS ET AL.	
Examiner	Art Unit	
SHIBRU HELEN	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/29/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, and 8 of U.S. Patent No. 6,034,738. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The subject matter of claim 1 can be found in patent claim 1. Patent claim 1 recites a digital apparatus for reproducing a digital video representative signal stored on a recorded medium connected to a receiving device including a decoder, said apparatus comprising means for processing said digital video representative signal stored on the recorded medium to produce an output signal bit stream for decoding by the decoder; means for generating a display message representative of an operating mode of said apparatus; means for receiving a decoded video signal representative of said decoded output signal bit stream from the decoder and said display message signal from said generating means for adding said display message to said decoded video signal; and means coupled to said generating means for synchronizing generation of said display message signal with said decoded video signal.

The subject matter of claims 3-4 can be found in claims 4, 7, and 8, respectively.

2. Claims 5-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 5, and 9 of U.S. Patent No. 6,034,738 in view of Mankovitz US Pat. No. 5,515,173.

Regarding claim 5, the subject matter in this claim can be found in claim 9 of Pat. No. 6,034,738. However Patent 6,034,738 fails to claim receiving means receiving and selecting a first compressed digital video signal from a network source and a second compressed digital video signal and a display message data signal from a local source, and control means for controlling selection between said first and second compressed digital video signals, and responsive to selection of said second compressed digital video signal.

In the same field of endeavor Mankovitz teaches receiving means (see receiver in fig. 1) receiving and selecting a first compressed digital video signal from a network source and a second compressed digital video signal and a display message data signal from a local source (see col. 7 line 65- col. 8 line 20 and 42-52). Mankovitz further teaches control means for controlling selection between said first and second compressed digital video signals, and responsive to selection of said second compressed digital video signal (see col. 31 lines 2-20 and col. 38 lines 27-44). Therefore it would have been obvious to one skill in the art at the time the invention was made to modify claim 9 of Patent 6,034,738 using Mankovitz in order to receive user's command.

The subject matter of claim 6 can be found in claim 9.

The subject matter of claim 7 can be found in claim 2.

The subject matter of claim 8 can be found in claim 5.

Regarding claims 9 and 10, the limitations of these claims can be found in claim 5 above. Therefore claim 9 and 10 are analyzed and rejected as discussed in claim 5 above.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Shibru whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
September 27, 2005


DAVID L. OMETZ
SUPERVISORY PATENT
EXAMINER